

REMARKS

Claims 3, 5, 8, 9, 10, 17, 18, 20, 25, 26, 28, 31, 33, and 35 have been amended. Claims 15-23 and 36-38 have been canceled. Claims 39-56 have been added.

Responsive to the action mailed October 5, 2004, Applicants elect the invention of Group II (claims 9-10) drawn to the embodiment of a BLyS binding polypeptide. Applicants elect species AGKEPCYFYWECAVSGPGPEGGGK (SEQ ID NO:163). At least claims 9-11, 39-44, 46, and 47 read on the elected species. The election is made with traverse.

Applicants respectfully request that the Examiner withdraw the restriction requirement with respect to Groups I, II, and III. Like claim 9 (a claim of Group II), the claims of Group I (claims 1-8) and Group III (claims 11-14) relate to a BLyS binding polypeptide. Indeed, the Examiner has classified all three Groups as being drawn to a BLyS binding peptide and as belonging to the same class and subclass.

Moreover, the scope of the claims of Group II and III are at least partially overlapping. Claim 9 has been amended to clarify the relationship between the amino acid sequence of formula H in claim 9 (SEQ ID NO:8) and the amino acid sequence of formula A in claim 11 (SEQ ID NO:1). Formula H is generic to formula A. Note further that SEQ ID NO:163 is a species of a number of claims, including claims 9, 11, 39, and 40. Since both claims 9 and 11 encompass the elected species (SEQ ID NO:163), claims 9 and 11 should be maintained in the same application. This approach would align the Office's restriction policy with the policies underlying obviousness-type double patenting.

In addition, Applicants submit that there is no serious burden on the Examiner to examine all the polypeptide claims together (Groups I, II, III). MPEP § 803 states that "[I]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Because Groups I and III are drawn to a BLyS binding peptide just as Group II is, a search can be made of these three groups together in the same application without serious burden. Further, a *prima facie* showing that restriction is proper has not been made in this case: "For purposes of

the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search" MPEP § 803. It has not been shown that Groups I, II, and III have a separate classification (in fact, the Examiner has stated that they have the same classification); separate status in the art; or a different field of search (the field of search would be the same). The Examiner states on page 8, "because the search for one group would not necessarily be inclusive of a search of another group, thus being burdensome to the examiner, restriction for examination purposes as indicated is proper." But since the search for Group II may be co-extensive to a significant degree with the search required for other groups, allowing these groups to be in the same application as Group II would not be unduly burdensome on the Examiner and serves the interest of efficiency by avoiding piece-meal prosecution.

To summarize, Applicants respectfully traverse as to the restriction between Group II and Groups I and III and request that the Examiner withdraw the restriction requirement with respect to these groups and examine claims 1-14 and 39-56 in the same application.

No statement herein is an admission that any claim is not patentably distinct from another or that any claim is obvious over another.

Applicants urge that at least claims 24-26, 28, 35, 55, and 56 should be rejoined upon allowance of the elected claims. Applicants reserve the right to rejoin any claim, including a claim of the group traversed above as appropriate and to traverse the restriction between the remaining groups at a later date.

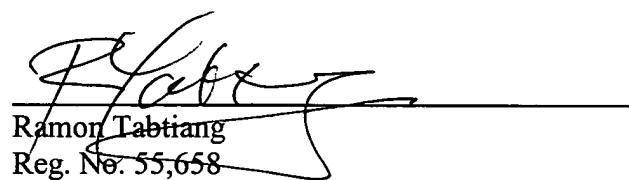
Applicant : Beltzer et al.
Serial No. : 09/932,322
Filed : August 17, 2001
Page : 23 of 23

Attorney's Docket No.: 10280-078001 / YA-00-05

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 5 Nov 2004


Ramon Tabtiang
Reg. No. 55,658

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

20969389.doc